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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,354	03/09/2001	Steven A. Sunshine	185641008110	7440
22428	7590	06/28/2005		
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			EXAMINER O'CONNOR, GERALD J	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/802,354

Applicant(s)

Sunshine et al.

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on April 19, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 56-58 is/are pending in the application.
- 4a) Of the above claim(s) 57 and 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the Office action mailed November 19, 2004 has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 19, 2005 has been entered.

Preliminary Remarks

2. This Office action responds to the amendment and arguments filed by applicant on April 19, 2005 in reply to the previous Office action, mailed November 19, 2004.

3. The amendment of claims 1, 56, 57, and 58 by applicant in the reply filed April 19, 2005 is hereby acknowledged.

Election/Restriction

4. Claims 57 and 58 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to non-elected inventions (Inventions V and VI, respectively), there being no allowable generic or linking claim. Applicant timely traversed the restriction requirement in Paper N^o 7.

Information Disclosure Statement

5. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, “the list may not be incorporated into the specification but must be submitted in a separate paper.” Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-8 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolawa et al. (US 6,370,513).

Kolawa et al. disclose a system for recommending a consumer product selection across a network, the system comprising: a recommendation engine comprising a first module (portion of functional descriptive material) for determining a difference between a plurality of consumer products having a plurality of descriptors by differentiating between at least one descriptor of the consumer products and providing the difference to a computer module; a descriptor module

(portion of functional descriptive material) for receiving descriptor input regarding the plurality of descriptors of at least a consumer product from at least two independent nodes on the network; a second module (portion of functional descriptive material) coupled to the recommendation engine for sorting between each of the consumer products to form at least two classes of the consumer products; a third module (portion of functional descriptive material) coupled to the recommendation engine for determining, for each consumer product, a correlation between the at least two classes and each of the descriptors, assigning a weighting term for each descriptor based upon the ability of each descriptor to sort between the at least two classes; and, a fourth module (portion of functional descriptive material) coupled to the recommendation engine for cooperatively operating on the weighting terms to provide a recommendation, but Kolawa et al. do not disclose that the descriptor module is configured to receive descriptor input from at least two independent consumers, since the descriptor input is received from retailers, not consumers. However, receiving feedback/reviews of products from consumers is well known to those of ordinary skill in the art (e.g., survey cards, focus groups, etc.), and official notice to that effect is hereby taken. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Kolawa et al. so as to receive the descriptor input from two consumers rather than two retailers, as is well known to do, in order to characterize the consumer products more accurately relative to reflecting the opinions of other consumers, as opposed to having to extrapolate from the opinions of retailers to the opinions of consumers.

Regarding claims 2-3, the nature of the particular consumer product being recommended by the system (wine, perfume, etc.) has been deemed merely a “for use” application of the claimed invention, hence, afforded little patentable weight (Kolawa et al. do, however, disclose a wine embodiment).

Regarding claim 4, each of the descriptors of the system of Kolawa et al. is (inherently) either an intrinsic (non-extrinsic) descriptor or an extrinsic (non-intrinsic) descriptor.

Regarding claims 5-6, each of the descriptors of the system of Kolawa et al. is in digital format, and is (inherently) either streaming (non-static) or static (non-streaming).

Regarding claim 7, the system of Kolawa et al. utilizes cluster mapping to generate the correlations between the consumer products and the at least two classes (see, in particular, column 12, line 35, to column 13, line 14).

Regarding claim 8, the network 12 of the system of Kolawa et al. is the Internet.

Regarding claim 56, the recited functional language characterizing the nature of the particular non-functional descriptive material being operated on by the claimed apparatus has been deemed merely intended usage of the claimed invention, hence, afforded little patentable weight. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See MPEP §2114.

Response to Arguments

8. Applicant's arguments filed April 19, 2005 have been fully considered but they are not persuasive.

9. Regarding the arguments with respect to the restriction requirement, note that the issue was closed when the requirement was made final. Further argument is no longer seasonable. See MPEP § 818.01.

10. Regarding applicant's desire to have certain of the non-elected inventions examined, applicant can have any of the separate inventions examined that applicant wishes to have examined, but the proper mechanism to do so is to file a divisional application, not to add them to the instant application. See MPEP §201.06.

11. The arguments regarding the previous prior art rejections have been considered, but have been rendered moot by applicant's amendment, and the consequent new grounds of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to the disclosure.

13. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at (571) 272-6771.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306.** Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

June 24, 2005

 (6-24-05)

Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627